

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 Patent Owner: Timothy N. Hentschel, et al. App. No.: 10/707,733
Examiner: Tonya S. Joseph Gr. Art Unit: 3628
Filing Date: January 8, 2004
For: **ONLINE GROUP RESERVATION SYSTEM**

10 **APPEAL BRIEF PURSUANT TO 37 CFR 41.37**

Dear Sir or Madam:

In reply to the *Notice of Panel Decision from Pre-Appeal Brief Review* dated July 27, 2010 and the Final Office Action dated March 15, 2010 ("Final Office Action"), Patent Owner
15 herein files an appeal brief for the above-identified application.

Real Party in Interest

Lexyl Travel Technologies, Inc. (the Patent Owner for Application Serial No.
20 10/707,733) is the real party in interest.

Related Appeals and Interferences

Not Applicable
25

Status of Claims

Claim 1 – 35, 39 – 58 were previously cancelled.

30 Claims 66 – 78 were previously withdrawn pending resolution of Applicant's traversal of the Examiner's requirement for restriction for these claims.

Claims 36 – 38 and 59 – 65 are now pending in the application.

35 Per the Final Office Action, Claims 36 – 38 and 59 – 65 each stand rejected.

Patent Owner herein explicitly appeals the rejection of Claims 36 – 38 and 59 – 65.

Status of Amendments

40 Patent Owner has not submitted amendments to any of the claims subsequent to final rejection (see Final Office Action dated May 28, 2010) of the above-identified claims.

Summary of Claimed Subject Matter

45 **Claim 36** – Independent Claim 36 sets forth a method for facilitating a hotel reservation described at, *inter alia*, paragraph [0019] of Applicant's specification as filed. The method

Application No. : 10/707,733
Filed : January 8, 2004

includes populating a computer database with participating bidders described at paragraph [0023] (and Fig. 3) of Applicant's specification as filed; configuring reverse auction parameters on one or more computer servers described at, *inter alia*, lines 5 – 17 of paragraph [0002] of Applicant's specification as filed; providing an online form to receive postings from a plurality of potential buyers via a network connection described at lines 5 – 17 of paragraph [0002] (and Fig. 2) of Applicant's specification as filed; performing a reverse auction on one or more computer servers in accordance with the reverse auction parameter to order bids from the participating bidders described at lines 5 – 8 of paragraph [0002] of Applicant's specification as filed; and transmitting an offer via the network connection to at least one of the potential buyers described at lines 5 – 17 of paragraph [0002] as well as lines 6 – 9 of paragraph [0020] of Applicant's specification as filed wherein the offer comprises an accepted bid described at paragraph [0029] of Applicant's specification as filed.

The reverse auction allows at least one of the participating bidders to submit more than one bid in response to the posting described at lines 27 – 28 of paragraph [0002] of Applicant's specification as filed. Contact information is provided via the network connection for a bidding party of the accepted bid to at least one of the potential buyers, to enable direct communication with the bidding party of the accepted bid to complete the transaction described at paragraph [0030] of Applicant's specification as filed. An administrative monitoring application is also provided that communicates with the computer database in order to access information associated with the participating bidders, as well as monitor the status of commissions associated with a completed hotel reservation described at paragraphs [0031] – [0032] of Applicant's specification as filed.

Grounds of Rejection to be Reviewed

1. Whether Claims 36 – 37, 59 – 60, 63 and 65 are unpatentable under 35 U.S.C. §103 as being obvious over Moshal et al. (U.S. Patent Pub. No. 2001/0042041, hereinafter "Moshal") in view of Ghouri et al. (U.S. Patent Pub. No. 2002/0082978, hereinafter "Ghouri") and further in view of Norrid (U.S. Patent Pub. No. 2003/0061145, hereinafter "Norrid").
2. Whether Claim 38 is unpatentable under 35 U.S.C. § 103 as being obvious over Moshal in view of Ghouri, Norrid and Pathak (U.S. Patent Pub. No. 2002/0016760, hereinafter "Pathak").
3. Whether Claims 61 – 62 and 64 are unpatentable under 35 U.S.C. § 103 as being obvious over Moshal in view of Ghouri, Norrid and Official Notice.

Arguments

I. Rejection of Claims 36 – 37, 59 – 60, 63 and 65 Under 35 U.S.C. § 103 as Being Obvious over Moshal, Ghouri and Norrid

Claim 36 – Per page 2 of the Final Office Action, Claim 36 stands rejected as being unpatentable over Moshal in view of Ghouri and further in view of Norrid. Applicant respectfully traverses the Office's rejection on multiple distinct grounds.

5 1. The Office has committed clear and reversible error by failing to establish a *prima facie* case for obviousness in rejecting Claim 36

Applicant notes that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the
10 applicant is under no obligation to submit evidence of nonobviousness (see MPEP § 2142). Furthermore, per MPEP § 2142:

15 *"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational*
20 *underpinning to support the legal conclusion of obviousness."* *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)." {emphasis added}

25 In rejecting Claim 36, the Examiner states at page 3, lines 14 – 16 of the Final Office Action that:

30 *"Moshal does not explicitly teach the limitation taught by Norrid providing an administrative monitoring application that monitor the status of commissions associated with a completed hotel reservation."* {sic}

With regards to Norrid, the above reasoning is the *only* discussion provided by the Examiner.

35 Firstly, the Examiner has provided no articulation that Applicant can see for why such a combination or modification to Moshal would have been obvious. Rather, the Examiner merely presents a conclusory statement with no rational underpinning or argument for why such a proposed modification to Moshal would have been obvious, as required by *KSR*.

Moreover, the Examiner has not provided any suggestion or motivation to combine the
40 aforementioned references in the Final Office Action, per MPEP § 2143.01.

Thirdly, and on a separate and distinct basis, Applicant respectfully submits that the Examiner has committed clear and reversible error in not considering each and every feature present within Applicant's Claim 36. It is well established that: *"All words in a claim must be considered in judging the patentability of that claim against the prior art."* *In re Wilson*, 424
45 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. As noted above, the Examiner in rejecting Claim 36 alleges that Norrid teaches *"providing an administrative*

Application No. : 10/707,733
Filed : January 8, 2004

monitoring application that monitor the status of commissions associated with a completed hotel reservation." {sic}. However, the claimed feature at issue in Claim 36 actually sets forth:

5 "... providing an administrative monitoring application that communicates with said computer database in order to access information associated with said plurality of participating bidders as well as monitor the status of commissions associated with a completed hotel reservation." {emphasis added}

10 Accordingly, even assuming *arguendo* that the Examiner's conclusory statement is true (which Applicant does not concede, as set forth in an additional argument presented below), the Examiner has respectfully ignored relevant claim language; i.e., the Examiner has not even considered whether such an administrative monitoring application (as allegedly disclosed by Norrid) communicates with a computer database to access information associated with the plurality of participating bidders.

15 Applicant submits that Norrid in fact does not teach the aforementioned limitations not addressed by the Examiner. Note that Applicant's Claim 36 recites "populating a computer database with a plurality of participating bidders;" {emphasis added}. The Examiner relies on Moshal to support his rejection of this limitation (see page 2, par. 3 of the Office Action). Norrid teaches or suggests only (i) an available rooms database, (ii) a guest profile database, and (iii) a database of the rates offered to the different groups making reservations, all three of the foregoing maintained by a hotel Property Management System (PMS). Hence, not only does Norrid not teach or suggest a bidder information database as set forth in Claim 36, but there would be no reason for the alleged "administrative monitoring application" (aka PMS) of Norrid to access any such database, since the PMS of Norrid does not in any way operate on or solicit bids.

20 Should the Examiner assert that Moshal teaches such a bidder information database, and that it would have been obvious for the alleged "administrative monitoring application" of Norrid to access this database, Applicant submits that such argument must necessarily fail on three distinct counts:

30 (i) Norrid can be considered to teach away from combination with Moshal to produce a bid-based system such as that of Applicant's Claim 36, since the intent of Norrid is to have the hotel (aka bidder) maintain control over prices ("*[0038] The prime benefit to this system is that the hotels have complete control over the rates that are offered and commissions and services fees allowed to agents and wholesalers.*"). Per MPEP 2141.02: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)". Implementing a bid system in Norrid would totally defeat the hotel maintaining "complete" control over prices.

40 (ii) There would be no motivation for the "administrative monitoring application" of Norrid to access a bidder information database. As noted above, there would be no reason for the alleged "administrative monitoring application" (aka PMS) of Norrid to

access any such database, since the PMS of Norrid does not in any way operate on or solicit bids.

(iii) Modification of Moshal or Norrid to meet the aforementioned new limitations would either (1) improperly change the basic principles of operation (“[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)”), or (2) render the invention unsuitable for the intended purpose (“[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)”), both in violation of MPEP 2143.01.

a. Specifically, modification of the hotel-controlled PMS of Norrid to access bidder information (pursuant to a bid-based system) would improperly change the basic operating principle of Norrid (i.e., the hotel running the PMS controls prices).

b. Similarly, modification of the Moshal system to include a monitoring application associated with a hotel-controlled PMS that accesses only PMS (hotel) related databases, and not anything to do with bidders, would render Moshal’s system inoperative of its intended purpose; i.e., the bidder-based system of Moshal could not operate as intended if using an application that accesses only (i) an available rooms database, (ii) a guest profile database, and (iii) a database of the rates offered to the different groups making reservations, all maintained by and under the control of a single hotel.

Therefore, for at least those reasons set forth above, Applicant submits that the Examiner has failed to establish a *prima facie* case for obviousness in rejecting at least Claim 36.

2. Norrid does not teach what the Office alleges

As discussed previously, Claim 36 sets forth and claims in part “*an administrative monitoring application that communicates with said computer database in order to ... monitor the status of commissions associated with a completed hotel reservation.*” {emphasis added} The Examiner alleges that Norrid teaches such functionality as claimed at paragraphs [0018] – [0019] and [0072] of Norrid.

Paragraphs [0018] – [0019] of Norrid only appear to discuss commissions generally, and do not appear to in any way describe an administrative monitoring application (and accordingly are not specifically discussed herein). Paragraph [0072] of Norrid sets forth:

“Additionally, upon confirmation of the reservation, the Octopus 21 may consult the rates datastore 200, calculate the commissions due to the booking party, if any, and record those for payment later, thereby generating a revenue pool 28 under the control and specification of the hotel.”

Application No. : 10/707,733
Filed : January 8, 2004

In other words, Norrid only teaches calculating the commissions due, and recording those calculations for later payment. Norrid does not teach nor suggest monitoring the *status* of these calculated commissions (e.g., and without limitation, whether or not they have been paid). See also for example, paragraph [0031] of Applicant's specification as filed which sets forth in part:

"This figured is called the "Accounting Information Page" because it also contains the status of paid commissions on accepted groups. This allows an administrator to track all commissions that are received or become past due."

Accordingly, Applicant respectfully submits that Norrid, in combination with Moshal and Ghouri, does not render obvious Claim 36.

Claims 37, 59 – 60, 63 and 65 – No arguments for Claims 37, 59 – 60, 63 and 65 are explicitly provided herein. Applicant submits that Claims 37, 59 – 60, 63 and 65 are in condition for allowance at least by virtue of its dependency from Claim 36 discussed above.

II. Rejection of Claim 38 Under 35 U.S.C. § 103 as Being Obvious over Moshal, Ghouri, Norrid and Pathak

Claim 38 – No arguments for Claim 38 are explicitly provided herein. Applicant submits that Claim 38 is in condition for allowance at least by virtue of its dependency from Claim 36 discussed above.

III. Rejection of Claims 61 – 62 and 64 Under 35 U.S.C. § 103 as Being Obvious over Moshal, Ghouri, Norrid and Official Notice

Claims 61 – 62 and 64 – No arguments for Claims 61 – 62 and 64 are explicitly provided herein. Applicant submits that Claims 61 – 62 and 64 are in condition for allowance at least by virtue of its dependency from Claim 36 discussed above.

Respectfully submitted,

GAZDZINSKI & ASSOCIATES, PC

Dated: October 11, 2010

By: 

Peter J. Gutierrez, III
Registration No. 56,732
16644 West Bernardo Drive, Suite 201
San Diego, CA 92127
Telephone No.: (858) 675-1670
Facsimile No.: (858) 675-1674

APPENDIX I - CLAIMS

1. – 35. (Cancelled)

5 36. (Previously presented) A method for facilitating a hotel reservation, comprising:
populating a computer database with a plurality of participating bidders;
configuring a plurality of reverse auction parameters on one or more computer servers;
providing an online form to receive postings from a plurality of potential buyers via a
network connection;

10 performing a reverse auction on said one or more computer servers in accordance with at
least one said reverse auction parameter to order a plurality of bids from said plurality of
participating bidders;

transmitting an offer via said network connection to at least one of said plurality of
potential buyers, wherein said offer comprises an accepted bid;

15 wherein said reverse auction allows at least one of said participating bidders to submit
more than one said bid in response to said posting;

providing contact information via said network connection for a bidding party of said
accepted bid to said at least one of said plurality of potential buyers to enable direct
communication with said bidding party of said accepted bid to complete the transaction; and

20 providing an administrative monitoring application that communicates with said
computer database in order to access information associated with said plurality of participating
bidders as well as monitor the status of commissions associated with a completed hotel
reservation.

25 37. (Previously presented) The method of Claim 36, wherein at least one bid in said
plurality of bids comprises an automated bid.

38. (Previously presented) The method of Claim 36, wherein said plurality of bids
includes a first bid and a second bid, wherein said plurality of participating bidders comprises a
first bidder and a second bidder, and wherein said first bid is hidden from said second bidder.

39. – 58. (Cancelled)

30 59. (Previously presented) The method of Claim 37, wherein said automated bid
comprises said accepted bid and said accepted bid is confirmed through multiple online hotel
booking engines.

Application No. : 10/707,733
Filed : January 8, 2004

60. (Previously presented) The method of Claim 36, wherein said contact information is not provided for said bidding party until said at least one of said plurality of potential buyers completes a qualification confirmation procedure.

61. (Previously presented) The method of Claim 60, wherein said qualification
5 procedure comprises receiving information associated with a credit card.

62. (Previously presented) The method of Claim 60, wherein said qualification procedure comprises receiving a telephone call from said at least one of said plurality of potential buyers.

63. (Previously presented) The method of Claim 36, wherein said act of transmitting
10 an offer via said network connection to at least one of said plurality of potential buyers comprises transmitting a bid notification email.

64. (Previously presented) The method of Claim 36, wherein said online form is provided on both a parent site and a private label site.

65. (Previously presented) The method of Claim 36, further comprising:
15 providing a participating bidder information page to at least a portion of said plurality of participating bidders, said participating bidder information page sharing information associated with said reverse auction between said at least a portion of said plurality of participating bidders.

66. (Withdrawn) A method for facilitating a hotel reservation, comprising:
populating a computer database located on one or more computer servers with a plurality
20 of participating bidders, said act of populating including information received via a hotel registration account page;

providing an online form to receive postings from a plurality of potential buyers via a network connection, said online form being provided on both a parent site and a private label site;

25 performing a reverse auction on said one or more computer servers so as to receive a plurality of bids from said plurality of participating bidders;

transmitting an offer via said network connection to at least one of said plurality of potential buyers, wherein said offer comprises a received bid from at least one of said plurality of participating bidders; and

30 providing a participating bidder information page via said network connection to at least a portion of said plurality of participating bidders, said participating bidder information page

Application No. : 10/707,733
Filed : January 8, 2004

containing information associated with said reverse auction between said at least a portion of said plurality of participating bidders.

67. (Withdrawn) The method of Claim 66, wherein said hotel registration account page permits individual ones of said plurality of participating bidders to specify a threshold
5 parameter, said threshold parameter governing whether or not a given participating bidder should be included in a given reverse auction.

68. (Withdrawn) The method of Claim 67, wherein said threshold parameter comprises a number of rooms requested for said given reverse auction.

69. (Withdrawn) The method of Claim 66, wherein an individual one of said postings
10 comprises a listing of multiple destinations in a single booking post.

70. (Withdrawn) The method of Claim 66, wherein at least one of said one or more servers further comprises a bidding entity, said bidding entity capable of submitting an automated bid to said posting.

71. (Withdrawn) The method of Claim 66, wherein said received bid further
15 comprises an accepted bid and said accepted bid does not necessarily comprise a lowest bid from said one or more bids.

72. (Withdrawn) The method of Claim 66, wherein:
said plurality of participating bidders comprises a first bidding party and a second bidding party, and said plurality of bids comprises a first bid and a second bid; and
20 wherein said first bid is submitted by said first bidding party, and said second bid is submitted by said second bidding party.

73. (Withdrawn) The method of Claim 72, wherein said first bid is hidden from said second bidding party.

74. (Withdrawn) The method of Claim 72, wherein said first bid is shown to said
25 second bidding party.

75. (Withdrawn) The method of Claim 66, wherein said act of providing said participating bidder information page via said network connection to at least a portion of said plurality of participating bidders is determined based at least in part on whether or not an individual bidder has selected to share information associated with its respective bid.

30 76. (Withdrawn) A method for facilitating a hotel reservation, comprising:

Application No. : 10/707,733
Filed : January 8, 2004

populating a computer database located on one or more computer servers with a plurality of participating bidders;

providing an online form to receive a posting from a potential buyer via a network connection;

5 performing a reverse auction on said one or more computer servers so as to receive a plurality of bids from said plurality of participating bidders;

providing a bidding entity executable on at least one of said one or more servers, wherein said bidding entity submits an automated bid for at least one of said plurality of participating bidders in response to said received posting; and

10 providing a potential buyer information page via said network connection to said potential buyer, said potential buyer information page sharing information associated with said plurality of bids to said potential buyer;

wherein said information on said potential buyer information page includes information that enables said potential buyer to determine whether or not a given one of said plurality of bids
15 has been automatically submitted.

77. (Withdrawn) The method of Claim 76, wherein said automated bid comprises an accepted bid and said accepted bid is confirmed through multiple online hotel booking engines.

78. (Withdrawn) The method of Claim 77, wherein different conditions apply to said potential buyer based on whether an accepted bid is automated or non-automated.

Application No. : 10/707,733
Filed : January 8, 2004

APPENDIX II - EVIDENCE

NONE

Application No. : 10/707,733
Filed : January 8, 2004

APPENDIX III – RELATED PROCEEDINGS

(See attached)

Appl. No: 10/707,733 Filing Date: January 8, 2004
In Re: Timothy N. Hentschel, et al. Examiner: Joseph, Tonya S.
Our Reference: LEXYL.001RC1 Group Art Unit: 3628

Entitled: **ONLINE GROUP RESERVATION SYSTEM**

Today's Date: Tuesday, June 15, 2010

The Patent Offices' stamp hereon acknowledges receipt of the following:

Papers: Pre-Appeal Brief Request for Review (1 Page);
Pre-Appeal Brief Request for Review Attachment (3 Pages);
Notice of Appeal (1 Page);
This return prepaid postcard.

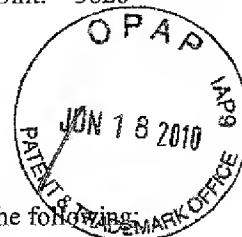
Appl. No: 10/707,733 Filing Date: January 8, 2004
In Re: Timothy N. Hentschel, et al. Examiner: Joseph, Tonya S.
Our Reference: LEXYL.001RC1 Group Art Unit: 3628

Entitled: **ONLINE GROUP RESERVATION SYSTEM**

Today's Date: Tuesday, June 15, 2010

The Patent Offices' stamp hereon acknowledges receipt of the following:

Papers: Pre-Appeal Brief Request for Review (1 Page);
Pre-Appeal Brief Request for Review Attachment (3 Pages);
Notice of Appeal (1 Page);
This return prepaid postcard.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket Number (Optional)

LEXYL.001RC1

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] June 15, 2010

Signature

Typed or printed name Peter J. Gutierrez, III

In re Application of
Timothy N. Hentschel, et al.

Application Number
10/707,733

Filed
January 8, 2004

For Online Group Reservation System

Art Unit
3628

Examiner
Joseph, Tonya S.

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))

\$ 540.00

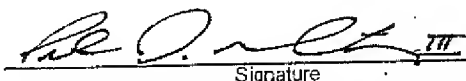
- ☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 501423.
- ☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

\$ 270.00

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 56,732
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____


Signature

Peter J. Gutierrez, III

Typed or printed name

858-675-1670

Telephone number

June 15, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0551-0031
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LEXYL001RC1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 15, 2010

Signature

Typed or printed Peter J. Gutierrez, III
name

Application Number

10/707,733

Filed

January 8, 2004

First Named Inventor

Timothy N. Hentschel, et al.

Art Unit

3628

Examiner

Joseph, Tonya S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 56,732

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Peter J. Gutierrez, III

Typed or printed name

858-675-1670

Telephone number

June 15, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐

*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 Applicant: Timothy N. Hentschel, et al. App. No.: 10/707,733
Examiner: Joseph, Tonya S. Group Art Unit: 3628
Filing date: January 8, 2004
For: **ONLINE GROUP RESERVATION SYSTEM**

10 **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir or Madam:

15 In response to the Office Action dated March 15, 2010 ("Office Action"), Applicant herein requests a pre-appeal brief review of the above-identified application as follows:

I. CLEAR ERROR IN ESTABLISHING A PRIMA FACIE CASE FOR OBVIOUSNESS UNDER 35 U.S.C. § 103

20 Per page 2 of the Office Action, Claims 36 – 37, 59 – 60, 63 and 65 each stand rejected under 35 U.S.C. § 103 as being unpatentable over Moshal et al. (U.S. Patent Pub. No. 2001/0042041, hereinafter "Moshal") in view of Ghouri et al. (U.S. Patent Pub. No. 2002/0082978, hereinafter "Ghouri") and further in view of Norrid (U.S. Patent Pub. No. 2003/0061145, hereinafter "Norrid"). Applicant respectfully submits that the Examiner has
25 committed clear and reversible error by failing to establish a *prima facie* case for obviousness in rejecting Claim 36.

Specifically, Applicant notes that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness (see MPEP
30 § 2142). Furthermore, per MPEP § 2142:

35 *"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)." {emphasis added}*

45 In rejecting Claim 36, the Examiner states at page 3, lines 14 – 16 of the Office Action that:

Application No. : 10/707,733
Filed : January 8, 2004

"Moshal does not explicitly teach the limitation taught by Norrid providing an administrative monitoring application that monitor the status of commissions associated with a completed hotel reservation." {sic}

5 With regards to Norrid, the above reasoning is the *only* discussion provided by the Examiner.

10 Firstly, the Examiner has provided no articulation that Applicant can see for why such a combination or modification to Moshal would have been obvious. Rather, the Examiner merely presents a conclusory statement with no rational underpinning or argument for why such a proposed modification to Moshal would have been obvious as required by KSR. Moreover, per MPEP § 2143.01, the Examiner must provide a suggestion or motivation, which appears wholly absent from the Office Action.

15 Secondly, and on a separate and distinct basis, Applicant respectfully submits that the Examiner has committed clear and reversible error in not considering each and every limitation present within Applicant's Claim 36. It is well established that: "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. As noted above, the Examiner in rejecting Claim 36 alleges that Norrid teaches "*providing an administrative*
20 *monitoring application that monitor the status of commissions associated with a completed hotel reservation.*" {sic} However, the limitation at issue in Claim 36 actually sets forth:

25 "... providing an administrative monitoring application that communicates with said computer database in order to access information associated with said plurality of participating bidders as well as monitor the status of commissions associated with a completed hotel reservation." {emphasis added}

30 Accordingly, even assuming *arguendo* that the Examiner's conclusory statement is true (which Applicant does not concede as set forth in an additional argument presented below), the Examiner has ignored relevant claim language; i.e., the Examiner has respectfully not even considered whether such an administrative monitoring application (as allegedly disclosed by Norrid) communicates with a computer database to access information associated with the plurality of participating bidders.

35 Therefore, for at least those reasons set forth above, Applicant submits that the Examiner has failed to establish a *prima facie* case for obviousness in rejecting at least Claim 36.

II. CLEAR ERROR IN ALLEGATIONS OF WHAT NORRID TEACHES

40 As discussed previously, Claim 36 sets forth and claims in part "*an administrative monitoring application that communicates with said computer database in order to ... monitor the status of commissions associated with a completed hotel reservation.*" {emphasis added} The Examiner alleges that Norrid teaches such functionality as claimed at paragraphs [0018] – [0019] and [0072] of Norrid. Paragraph [0072] of Norrid sets forth:

45

Application No. : 10/707,733
Filed : January 8, 2004

"Additionally, upon confirmation of the reservation, the Octopus 21 may consult the rates datastore 200, calculate the commissions due to the booking party, if any, and record those for payment later, thereby generating a revenue pool 28 under the control and specification of the hotel."

5 In other words, Norrid only teaches calculating the commissions due and recording those calculations for later payment. Norrid does not teach nor suggest monitoring the status of these calculated commissions (e.g., and without limitation, whether or not they have been paid). See also for example, paragraph [0031] of Applicant's specification as filed which sets forth in part:

10 *"This figured is called the "Accounting Information Page" because it also contains the status of paid commissions on accepted groups. This allows an administrator to track all commissions that are received or become past due."*

15 Accordingly, Applicant respectfully submits that the Examiner has committed clear and reversible error on this independent and distinct basis as well.

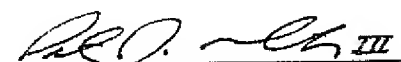
III. CONCLUSION

20 In summation, Applicant respectfully submits that the Examiner has committed clear and reversible error in at least those instances described above. Accordingly, Applicant requests that the Final Rejection for the above-identified case be withdrawn, and that the case be passed to allowance, or that a subsequent Office communication correcting the above highlighted deficiencies be issued.

25 Respectfully submitted,

GAZDZINSKI & ASSOCIATES, PC

30 Dated: June 15, 2010

By: 
Peter J. Gutierrez, III
Registration No. 56,732
16644 West Bernardo Drive, Suite 201
San Diego, CA 92127
Telephone No.: (858) 675-1670
Facsimile No.: (858) 675-1674




UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,733	01/08/2004	Timothy Noel Hentschel	LEXYL.001 <i>RCI</i>	1732
27299 7590 07/27/2010 GAZDZINSKI & ASSOCIATES, PC 16644 WEST BERNARDO DRIVE SUITE 201 SAN DIEGO, CA 92127				
EXAMINER JOSEPH, TONYA S				
ART UNIT 3628		PAPER NUMBER		
MAIL DATE 07/27/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application Number 	Application/Control No. 10/707,733 JOHN W. HAYES	Applicant(s)/Patent under Reexamination HENTSCHEL ET AL. Art Unit 3628
Document Code - AP.PRE.DEC		

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 6/18/2010.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 36-38, 59-65.

Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) /JOHN W. HAYES/

(3) /Tonya Joseph/

(2) /Igor Borissov/

(4) _____